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S. Robert Chuev 39,140
Name of Attorney/Agent Registration No.
Signature of Attorney

R. Kent
11/20/03
#11

P&G Case 7984

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of

PIOTROWSKI, Robert David, et al.

Serial No. 09/804,819

Filed March 13, 2001

:

Confirmation No. 2044

:

Group Art Unit 3722

:

Examiner Monica Smith Carter

For METHODS FOR DIRECTING CONSUMERS TO PREFERRED COFFEE SELECTION

APPELLANT'S REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

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TECHNOLOGY CENTER R3700

Dear Sir:

Appellants hereby Reply to the Examiner's Answer mailed September 12, 2003.

ISSUES

Do Claims 1-11, 16, 17, 20-30, 32, 33, 53-63, 65 and 66 produce a "concrete" result as required under 35 U.S.C. § 101?

Are Claims 1-11, 16, 17, 20-30, 32, 33, 53-63, 65 and 66 obvious over US Patent No. 5,568,763, to Kunzler, under 35 U.S.C. § 103 (a)?

ARGUMENTS

Rejection under 35 USC § 101

A. The Examiner's Answer

In the Answer, the Examiner maintains the rejection of Claims 1-11, 16, 17, 20-30, 32, 33, 53-63, 65 and 66 under 35 USC § 101 for allegedly lacking usefulness because the method of the present claims do not produce a "concrete" result. The Examiner states, "It cannot be conclusively determined that the particular Cues as set forth by appellant will direct a consumer to purchase a particular type of coffee. The result of the appellant's invention is speculative". Answer at page 5.

Respectfully, the Examiner's argument can be summarized as follows "I don't think it works." The Appellants have three comments regarding the Examiner's argument: 1) the present invention does work; 2) the Examiner's argument is equally speculative as the Examiner has submitted no proof of this assertion, and, 3) the Examiner's assessment of the likelihood of

success for the present invention is legally irrelevant. More specifically, this is not a legally supportable rejection.

The Appellants have not claimed a perpetual motion machine, nor is the present invention frivolous, fraudulent or against public policy. Nor are the present claims directed to a scientific principle, a naturally occurring article, or printed matter. These are the classes of inventions listed in the MPEP Section 706.03(a) as appropriate subject matter for a § 101 rejection. The present claims fall into none of these categories.

Regarding the Examiner's assertion that "The result of the appellant's invention is speculative", this is outside the scope of the patent examination process. When the Archer Daniel Midland Company submits a patent application for genetically modified corn, does the US PTO plant the seeds to see if they grow corn? Are multiple fields of different varieties of corn planted side by side to check the alleged improve yield of the seeds? Are the fields shielded from the rain to insure the claims to drought tolerance are substantiated? The answers are no, no and no. It would be ludicrous to impose on the limited resources of the US PTO the obligation to verify that each and every invention submitted performs the stated "useful" purpose. As the PTO does not perform this function, and this function forms no part of the patent examination process, it is legally improper for the Examiner to base a rejection on what is nothing more than a factually unsupported belief that the claimed results are "speculative".

Ultimately, the present claims define a method that produces a "useful, concrete, and tangible result", which is, the consumer purchases a coffee product that is best suited to their lifestyle and tastes. As such, the present claims are patentable subject matter under 35 USC § 101 and it is respectfully requested that the present rejection be overturned.

The Rejection Under 35 U.S.C. § 103(a)

A. The Examiner's Answer

In the Answer, the Examiner maintains the rejection of Claims 1-11, 16, 17, 20-30, 32, 33, 53-63, 65 and 66 under 35 USC § 103 for allegedly being obvious in light of US Patent No. 5,568,763, which issued to Kunzler.

The Examiner states that Kunzler teaches a coffee brewing device that allows the consumer to select the size and strength of the coffee based on indicia on the machine. Moreover, the Examiner goes on to assert that because the machine in Kunzler can be used for "other types of coffee", that it renders the present claims obvious. Answer at page 6.

Kunzler, starting at Column 3, line 30, admittedly discloses that the machine can provide numerous different choices to a consumer, for example, a small cup of decaffeinated coffee, versus a large cup. The Appellant's do not contest that other choices of coffee would fit within

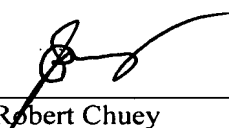
the teachings of Kunzler, for example, French roast, espresso, espresso with milk, Sumatra with cream, etc. The list of choices could extend indefinitely. But the present claims are not directed to simply providing more choices for the consumer. If that were the case, the claims would not be novel over the coffee isle at any local suburban grocery store. The present claims are directed to using Multiple Self-Characterization Cues comprising one Abstract Lifestyle/Personality Cue to help the consumer make a selection (among the myriad of choices) that is tailored to that consumer's tastes and preferences. Kunzler, and the prior art in general, simply presents the consumer with choices. The present claims are directed to a scientific method the consumer can use to make the best selection from the numerous options available. Thus, the present claims go far beyond the teachings of Kunzler.

Thus, the present methods are not taught or suggested in Kunzler, or the other references made of record in the present case. As such, the Applicant respectfully requests that the rejection of the present claims under § 103 be overturned.

CONCLUSION

In light of the above remarks, it is requested that the Board reconsider and overturn the rejections of the present claims under 35 USC §§ 101 and 103(a). Early and favorable action in the case is respectfully requested.

Respectfully submitted,
For: PIOTROWSKI, *et al.*

By 

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Date: November 12, 2003
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Enclosed, pursuant to 37 CFR 1.193(b)(1), is the Reply Brief for the above application.

We do not believe a fee is due. If, however, a fee is due, the Director is authorized to charge any fee which may be required to Deposit Account No. 16-2480. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

By *SR Chuey / sbs*
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Date: November 12, 2003

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